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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,873	03/22/2001	Hideki Sogabe	5664-00200/EBM	6063

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EXAMINER

WINDER, PATRICE L

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 04/05/2004

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,873

Applicant(s)

SOGABE ET AL.

Examiner

Patrice Winder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The substitute specification filed March 22, 2002, paper #5, has not been entered because it does not conform to 37 CFR 1.125(b) and (c) because: there is no statement that the substitute specification includes no new matter.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 6-8, 10-11, 13-15, 17 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Mages et al., USPN 6,463,467 B1 (hereafter referred to as Mages).

4. Regarding claim 1, Mages taught a service system (abstract) comprising:
a digital versatile disc having a first file which stores video and audio information and a second file which stores playback control information for the information in the first file, the information being normally unable to be played back from said digital versatile disc (column 6, lines 48-54, 58-62, column 7, lines 2-8);

a terminal connected to a network and adapted to receive said digital versatile disc (column 6, lines 20-25); and

a server arranged in the network and having repair information which can repair the information in said digital versatile disc (column 6, lines 18-20), said server returning the repair information to said terminal (column 6, lines 30-32) and causing said terminal to playback the information from said digital versatile disc upon receiving a playback request for the information in said digital versatile disc from said terminal when said terminal uses said digital versatile disc (column 6, lines 32-38).

5. Regarding claim 6, Mages taught a learning system (abstract) comprising: a digital versatile disc having a first file which stores video and audio information, and a second file which stores playback control information for the first file, wherein the said digital versatile disc is incomplete, requiring repair for playback (column 6, lines 48-54, 58-62, column 7, lines 2-8);

a terminal connected to a network and adapted to receive and playback information in said digital versatile disc (column 6, lines 20-25); and

a server arranged in the network and having a memory comprising repair information for said digital versatile disc (column 6, lines 18-20, column 7, lines 20-22).

6. Regarding dependent claim 7, Mages taught the terminal is a personal computer that allows access to the Internet (column 7, lines 57-60).

7. Regarding dependent claim 8, Mages taught the terminal comprises a playback assistant for repairing the information in said digital versatile disc in accordance with repair information (column 7, line 66-column 8, line 2).

8. Regarding dependent claim 10, Mages taught the memory of the server is further configured to store page contents of a subject (column 7, lines 10-12).

9. Regarding dependent claim 11, Mages the server is used by or integrated with a number of other servers (column 7, lines 5-8, 14-17).

10. Regarding claim 13, Mages taught a learning method (abstract) comprising:
providing a digital versatile disc having a first file which store video and audio information and a second file which store playback control information for the information in the first file, wherein the information on the said digital versatile disc is incomplete, repair for playback (column 6, lines 48-54, 58-62, column 7, lines 2-8);

placing the said digital versatile disc into a terminal coupled through a network to a server (column 6, lines 20-25), wherein the server comprises a memory in which repair information and playback control instruction for said digital versatile disc are registered (column 6, lines 18-20); and

transmitting repair information from the server to the terminal, wherein the terminal allows playback of the information in said digital versatile disc (column 6, lines 30-38).

11. Regarding dependent claim 14, Mages taught the terminal is configured to received and playback information in the said digital versatile disc (column 8, lines 12-22).

12. Regarding dependent claim 15, Mages taught the terminal comprises a playback assistant for repairing the information in said digital versatile disc in accordance with the repair information (column 7, line 66-column 8, line 2).

13. Regarding dependent claim 17, Mages taught the memory of the server is further configured to store page contents of a subject (column 7, lines 10-12).

14. Regarding dependent claim 19, Mages the server is used by or integrated with a number of other servers (column 7, lines 5-8, 14-17).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

17. Claims 2-4, 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages in view of Parker et al., USPN 5,909,589 (hereafter referred to as Parker).

18. Regarding dependent claim 2, Mages taught said server comprises first and second servers (column 7, lines 5-12),

said second server having a second memory in which a pair of repair information and playback control instruction information for said digital versatile disc are registered

in relation to playback designation information output when said terminal sends the playback request (column 6, lines 18-20, column 7, lines 38-45) and

the first server outputting playback designation information to said second server (column 6, lines 42-44, column 7, lines 57-64) and causing said second server to transmit, to said terminal, the repair information corresponding to the playback designation information for said digital versatile disc in said second memory, thereby allowing said terminal to playback the information in said digital versatile disc (column 7, lines 14-27).

Mages does not specifically teach particulars of the first server. However, Parker taught a first server having a database in which a pair of identification information of a student who learns a subject using said terminal and progress information of the subject are registered (column 9, lines 31-34, column 10, lines 7-9), and having a first memory which stores contents of each page of the subject (column 8, lines 48-52), and said first server transmitting page contents of said first memory designated by the progress information corresponding to the identification information of the student in said database and causing said terminal to display the contents at the time of learning by the student (column 8, lines 48-52), and

said first server transmitting page contents of said memory designated by the progress information corresponding to the identification information (column 8, lines 48-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Parker's tracking progression in Mages' system for controlling local media playback would have improved system effectiveness. The

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motivation would have been to further insure the integrity of a student using the local media playback.

19. Regarding dependent claim 3, Mages taught said terminal comprises:

a player for playing back the information in said digital versatile disc (column 6, line 23);

playback assistant means for repairing the information in said digital versatile disc, which is played back by said player, on the basis of the repair information (column 7, line 66-column 8, line 2); and

playback means for, upon receiving the repair information and playback control information, sending the received repair information to said playback assistant means, instructing said playback assistant means and player to playback said digital versatile disc on the basis of the received information, and displaying playback information of the first file of said digital versatile disc on the basis of a repair output from said playback assistant means (column 8, lines 12-32).

20. Regarding dependent claim 4, Mages taught said second server has first and second playback control means for controlling playback of the information in said digital versatile disc (column 6, lines 40-47),

said second server cause said second playback control means in accordance with authentication information of said terminal and said second playback control means acquired by said terminal means transmits the playback designation information to said first playback control means (column 7, lines 2-5),

upon receiving the playback designation information, said first playback control means sends the repair information in said second memory, which corresponds to the playback designation information, to said second playback control means and causes said second playback control to send the repair information to said playback means (column 7, lines 14-22), and after the repair information is sent, said second playback control means requests said first playback control means to send the playback control instruction information (column 7, lines 22-29), and

upon receiving the sending request, said first playback control means sends the playback control instruction information in said second memory, which corresponds to the playback designation information, to said second playback control means and causes said second playback control means to send the playback control instruction information to said playback means (column 7, lines 20-29).

Mages does not specifically teach authentication information which is output from said first server when said terminal sends a playback request for the information in said digital versatile disc. However, Parker taught authentication information which is output from said first server when said terminal sends a playback request for the information in said digital versatile disc (column 9, lines 1-4). For motivation for combination see claim 2, above.

21. Regarding dependent claim 9 and 16, Mages does not specifically teach the server is configured with a database comprising registration information of student identification and subject progress. However, Parker taught a server is configured with a database comprising registration information of student identification and subject

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progress (column 9, lines 31-34, column 10, lines 7-9). For motivation for combination see claim 2 above.

22. Regarding dependent claim 18, Mages taught the page contents of a subject is transmitted from the memory to the terminal to be displayed (column 7, lines 38-45).

23. Claims 5,12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages in view of Mages et al., USPN 6,035,329 (hereafter referred to as Mages_2)

24. Regarding dependent claim 5, Mages does not specifically teach charging means for charging for use said digital versatile disc. However, Mages_2 taught charging means for charging for use of a digital versatile disc (column 5, lines 8-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made that incorporating Mages_2's charging in Mages' system for playback would have improved system effectiveness. The motivation would have been to provide a mechanism for handling pay-per-view discs.

25. Regarding dependent claim 12 and 20, Mages does not specifically teach a charging method is employed for use of said digital versatile disc. However, Mages_2 taught a charging method is employed for use of a digital versatile disc (column 5, lines 8-20). For motivation for combination see claim 5, above.

Conclusion

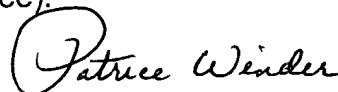
26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. McManus et al., USPN 6,408,315 B1 : taught a computer-based training using digitally compressed and streamed multimedia presentations.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrice Winder whose telephone number is 703-305-3938. The examiner can normally be reached on Monday-Friday, 10:30 am-7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 703-308-3662. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patrice Winder
Primary Examiner
Art Unit 2155

plw